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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re American Refining Group, Inc.

Serial No. 76/069,243

Robert E. Rosenthal of Duane Morris LLP for American
Refining Group Inc.

Glenn Clark, Trademark Examining Attorney, Law Office 115
(Thomas Vlcek, Managing Attorney).

Before Cissel, Quinn and Drost, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On June 13, 2000, applicant, a corporation organized
and existing under the laws of Pennsylvania, applied to
register the mark SECURITY on the Principal Register for
"motor oil and lubricating oils," in Class 4. The basis
for filing the application was applicant's assertion that
it possessed a bona fide intention to use the mark in
commerce in connection with these products.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d), on the grounds that applicant's mark so resembles two registered marks that if applicant were to use its mark in connection with the goods set forth in the application, confusion would be likely. The two cited marks are



registered for "automotive anti-freeze solutions";¹ and



registered for "oil, air and transmission filters and PVC valves for wholesale end use in passenger automobiles and light trucks."² In support of the refusal to register, the Examining Attorney attached copies of seven third-party

¹ Reg. No. 1,447,007, issued to Houghton Chemical Corp. on July 14, 1987; affidavits under Sections 8 and 15 accepted and acknowledged.

² Reg. No. 1,821,194, issued to Security Filter Products Co. on February 15, 1994; affidavit under Section 8 accepted.

registrations wherein the goods listed include antifreeze, motor oil and filters.

In response to the first Office Action, applicant amended the application to identify the goods with which it intends to use the mark as "motor oil and general purpose lubricating oil," in Class 4, and argued that confusion would not be likely between applicant's mark and either of the two cited registered marks.

In support of its arguments, applicant included copies of pages from the website of the owner of the registration for the SECURITY FILTERS and design mark. This evidence shows that that registrant directs advertising to "the fast lube industry," i.e., shops specializing in quick oil and filter changes. Applicant argued that these sophisticated purchasers know the source of the products they purchase and will readily distinguish between the registered mark and applicant's mark. Additionally, argued applicant, applicant's mark is different in sound and appearance from this registered mark, and the goods listed in the registration, filters and valves, are different from the products identified in the application. Applicant contended that the third-party registrations listing oil and oil filters are either the result of licensing programs based on strong marks, or private label programs of

retailers or wholesalers. Applicant submitted a copy of a web page from one of the third-party registrants which shows that it is a wholesale distributor of automotive supplies, and argued that the owner of another one of these third-party registrations is the publisher of an automotive magazine, so that the registration of the magazine's trademark for these goods indicates a licensing program, rather than the fact that one manufacturer produces antifreeze, oil and filters. Another web page was also submitted, this one from the website of the owner of another one of the third-party registrations made of record by the Examining Attorney. It shows that the owner is a chain of auto parts supply stores. Applicant argued that the mark registered by that entity is for private label products sold by this chain of stores.

With regard to the other cited registration, for the mark SECURITY shown in block lettering for antifreeze, applicant argued that the marks are visually distinct and that the goods identified in the application, motor oil and general purpose lubricating oil, are very different from antifreeze in that that they are not used together and are not interchangeable. Further, argued applicant, consumers would not expect these goods to emanate from the same entity. Applicant reiterated its contention that the

third-party registrations cited by the Examining Attorney wherein the lists of goods include motor oil and antifreeze are generally private label brands or the result of licensing strong marks on a wide variety of products, so that these registrations are not indicative that the public would expect motor oil and antifreeze to have the same source.

The Examining Attorney was not persuaded by applicant's arguments. The refusal to register under Section 2(d) the Lanham Act was made final in the second Office Action.

Applicant timely filed a Notice of Appeal concurrently with a Request for Reconsideration. Submitted with this request in order to show that consumers are accustomed to distinguishing among automotive products using SECURITY were an advertisement for a Ford SECURITY SYSTEM, an UNGO automotive security system and a BLACK WIDOW security system for vehicles. Applicant reiterated its arguments that the goods in the cited registrations are different from applicant's goods and that the marks are significantly different in sound, meaning and appearance.

The Board instituted the appeal, but suspended action on it and remanded the application file to the Examining

Attorney for reconsideration in view of applicant's request.

The Examining Attorney continued the refusal to register and submitted additional evidence in support of his position. He maintained that applicant's mark is similar in sound and connotation to the first cited registered mark and that it also creates the same commercial impression. He reiterated his position that applicant's mark has the same connotation and creates the same commercial impression as the second cited registered mark. As additional support for his contention that the goods set forth in the application are commercially related to the products specified in the two cited registrations, he submitted additional third-party registrations and pages from the websites of several of applicant's competitors. Examples of the third-party registrations submitted include Texaco's registration of its Havoline mark for oil filters and air filters;³ Texaco's registration of the same mark for motor oils and industrial oils;⁴ Texaco's registration of the same mark for antifreeze;⁵ Pennzoil's registrations of

³ Reg. No. 2,553,968, issued on the Principal Register on March 26, 2002

⁴ Reg. No. 2,543,561, issued on the Principal Register on February 26, 2002;

⁵ Reg. No. 2,543,560, issued on the Principal Register on February 26, 2002

its mark for oil filters, air filters and crankcase breathers for internal combustion engines,⁶ anti-freeze⁷ and motor oils;⁸ as well as similar registrations of marks owned by other oil companies and retail businesses in the field of automotive supplies, all of whom have used and/or registered their marks for products which include motor oils, lubricants, automotive filters and antifreeze. The website excerpts submitted by the Examining Attorney show that automotive service retailers, oil companies and automotive manufacturers use their marks on motor oil as well as filters and other lubricants, and that both technicians and do-it-yourselfers use oil and filters together when performing oil changes.

After responding to the request for reconsideration, the Examining Attorney returned the application to the Board, which resumed action on the appeal. Applicant timely submitted its appeal brief and the Examining Attorney submitted his brief on appeal. Applicant filed a reply brief, and both applicant and the Examining Attorney presented their arguments at the oral hearing which applicant requested.

⁶ Reg. No. 1,505,755, issued on the Principal Register on Sept. 27, 1988.

⁷ Reg. No. 857,723, issued on the Principal Register on Oct. 1, 1968; renewed.

⁸ Reg. No. 719,150, issued August 1, 1961; renewed.

The issues before the Board in this appeal are whether applicant's mark, SECURITY, so resembles the two cited registered marks that confusion would be likely if applicant used its mark in connection with motor oil and general purpose lubricating oil. We find that these marks create similar commercial impressions and that the goods with which they are, or are intended to be, used are related in such a way that the purchasers of them would be likely to assume, mistakenly, that the use of these similar marks in connection with such products indicates that they emanate from the same source.

The predecessor to our primary reviewing court set forth the factors to be considered in determining whether confusion is likely in the case of *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Chief among these factors are the similarity between the marks themselves as to appearance, pronunciation, connotation and commercial impression and the relatedness of the goods or services in connection with which they are, or will be, used. Any doubt as to the issue of likelihood of confusion must be resolved in favor of the registrant or registrants and against the applicant, who has a legal duty to select the mark which is not likely to cause confusion with a trademark already in use in the marketplace. *In re*

Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025
(Fed. Cir. 1988).

We will discuss the issue of likelihood of confusion with each cited registered mark separately. Turning first to the mark in Reg. No. 1,477,007, we note that applicant's mark is legally identical to this mark because applicant's mark is the word "SECURITY" presented in typed form, which encompasses the block-letter script in which the same word is presented in the cited registered mark. Clearly, these two marks are similar in appearance, pronunciation and meaning, and they create the same commercial impression.

The issue thus becomes whether the use of these legally identical marks in connection with automotive antifreeze solutions, on one hand, and motor oil, on the other, is likely to lead to confusion. The third-party registration evidence made of record by the Examining Attorney establishes a reasonable basis upon which we can conclude that these goods are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988). The Internet evidence made of record by the Examining Attorney shows that an automobile maintenance service company, JiffyLube, not only renders oil change services, which include providing oil

and filters, but also checks and tops off vital fluids, including antifreeze. Antifreeze and oil are both used in the maintenance of automobiles, whether by professional mechanics or by do-it-yourselfers, and both can be purchased in ordinary auto supply stores for this purpose.

In view of the identity of the marks and the fact that the goods in question are related in this way, the likelihood of confusion between applicant's mark and the mark in Reg. No. 1,477,007 is clear.

We therefore turn to consideration of the mark in Reg. No. 1,821,194, SECURITY FILTERS and design. We agree with the Examining Attorney that the commercial impression created by this mark is very similar to the one created by the mark which applicant seeks to register. While we cannot ignore the descriptive, and hence disclaimed, word "filters" in this registered mark, we can recognize that this term has less source-identifying significance than the dominant element of the mark, the word SECURITY. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); and *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976). When considered in its entirety, SECURITY FILTERS and design in connection with filters is quite similar in connotation and commercial impression to the mark applicant seeks to register,

SECURITY, in connection with motor oil and general purpose lubricating oil. Applicant's mark consists of the dominant portion of the registered mark, and both marks have the same suggestive connotation in connection with the goods specified in the cited registration and the application, respectively. That the word "security" is used in connection with automotive security systems is not surprising, nor does this fact make the term weak in source-identifying significance for unrelated automotive products.

Whether confusion would be likely thus boils down to whether the goods listed in this registration are so closely related to the goods specified in the application that the use of these similar marks on both would be likely to cause confusion. The materials submitted by the Examining Attorney establish that motor oil has this kind of relationship to the filters and valves identified in the cited registration. Just as the third-party registrations demonstrate a basis for concluding that antifreeze and motor oil may emanate from a single source, the third-party registrations submitted by the Examining Attorney listing filters, oil and crankcase ventilation valves provide a basis upon which we can conclude that purchasers of motor oil, oil filters and PVC valves sold under these similar

marks would likely assume a common source for them all. See Albert Trostel & Sons Co., *supra*. In addition, the Internet evidence the Examining Attorney provided shows that oil and oil filters are complementary products, used by the same people in accomplishing a single mechanical operation, changing the oil in an automobile.

Applicant argues strenuously that because the registration states that registrant's filters and valves are "for wholesale end use in passenger automobiles and light trucks," the trade channels through which registrant's products move are different from the channels through which applicant's motor oil and lubricants will move. We interpret the language used in the registration to mean that registrant's filters and valves are sold to commercial enterprises who use these products to maintain either their own businesses' automobiles and trucks or automobiles and trucks owned by others. If this is the case, confusion would nonetheless be likely, in that the people purchasing registrant's filters and valves for their businesses would be the same ones who purchase the motor oil and lubricants used by such businesses. Such people are arguably sophisticated in the field of such goods, but even so, if they were familiar with the oil filters sold under the SECURITY FILTERS and design mark, they would be

likely, upon being presented with SECURITY brand motor oil, to assume that a single source is responsible for both products. That they may be sophisticated with respect to automotive technology, repair and maintenance does not necessarily translate into sophistication with regard to trademarks or into immunity from confusion caused by the use of marks which are so similar on such closely related products. See *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988).

The channels of trade for registrant's filters are restricted to wholesale end users, but without any restrictions or limitations in the identification-of-goods clause in the application, applicant's goods may be presumed to move through this same trade channel to the same end users. Applicant's argument that differences in the trade channels through which these products move makes confusion unlikely is therefore not well taken.

In summary, the Examining Attorney has satisfied his burden of establishing a basis for concluding that confusion between applicant's mark and each of the cited registered marks would be likely if applicant were to use its mark in connection with the goods identified in the application. Applicant has not provided any reasonable basis upon which we could reach a different conclusion.

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DECISION: The refusals to register under Section 2(d)
the Lanham Act are both affirmed.